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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,358	08/02/2001	Tomoharu Kurita	212865	6028
23460	7590	04/08/2004	EXAMINER	
LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6780			KRUER, KEVIN R	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/921,358

Applicant(s)

KURITA ET AL. 

Examiner

Kevin R Kruer

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 02 March 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.Claim(s) objected to: NONE.Claim(s) rejected: 1-5,7 and 18-26.Claim(s) withdrawn from consideration: NONE.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

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Applicant's proposed amendment filed March 2, 2004 has been entered. The amendment canceled the withdrawn claims and corrected typographical errors in claims 1 and 20.

Applicant's arguments have been fully considered, but are not persuasive. Applicant argues that Ohmura in view of Akahoshi does not teach the flexible metal-clad laminate recited in the pending claims. In support of their position, Applicant has filed a Declaration of Tomoharu Kurita in which a flexible metal-clad laminate is produced using a polyamide-imide resin described in Ohmura. However, the polyamide-imide resin selected from Ohmura does not represent the closest prior art. Specifically, the polyamide-imide resin species selected (i.e. the resin utilized in Experiment 1(a) of Run No. 1 as described in Ohmura) by Mr. Kurita is not the species relied upon by the examiner in the rejection. Thus, the Kurita Declaration fails to overcome the rejection of Ohmura in view of Akahoshi.

With regard to the rejection of claims under 35 U.S.C. 103(a) as being unpatentable over Watanabe in view of Frost and Akahoshi, Applicant argues that Akahoshi does not describe a condensation polymer having the claimed insoluble content. Specifically, Applicant argues that the "curing" of the polymer referred to in Watanabe (col 4, line 34) refers to the curing of the intermediate polyamic acid to polyamide-imide. Applicant contends that such "curing" as described by Frost is completely different from the intermolecular "crosslinking" of the present invention. The examiner respectfully disagrees with applicant's conclusion. Frost teaches that the

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resulting polymer is insoluble (col 9, line 9; col 3, lines 29+). Furthermore, polyamide-imide is taught by the prior art to be insoluble (see US 4,058,503; col 1, lines 26+). The prior art further suggests that the polyamide-imide will undergo crosslinking during the conversion of the polyamic acid to polyamide-imide (see US 4,167,620; col 1, lines 36+ and US 4,433,131, col 2, lines 16+). Thus, Applicant's arguments are not persuasive.

In response to the Examiner's Comments in the Final Office Action mailed September 5, 2003, the Kurita Declaration provides data (Experiment 2) to demonstrate that the examples in the specification agree in scope with the claims. Kurita performed experiments to demonstrate that the examples in the specification satisfy the requirements of claim 1. The data has been fully reviewed and considered. The data, however, is not sufficient for overcoming the outstanding rejections because the data fails to distinguish the claimed invention from the prior art.

The Kurita Declaration also contains an experiment (Experiment 3) to demonstrate that the polymer of Example 9 in the specification does not undergo crosslinking by heat-treating at 200°C. The experiment has been fully reviewed and considered, but is not sufficient for overcoming the outstanding rejections. Specifically, applicant argues that a polyamide-imide resin does not have an insolubility that exceeds 1% when heat-treated at 200°C for 20 hours. However, the polyamide-imide polymer taught by Frost is taught to be insoluble (col 3, lines 28+). Thus, the experiment fails to compare the invention to the closest prior art.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin R. Kruer
Patent Examiner-Art Unit 1773



Paul Thibodeau
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